

REMARKS

Claims 1-117 are pending in the instant application, of which claims 43-50, 52, 53, and 55-107 are withdrawn from consideration. Claims 1-107 were canceled previously, and claims 108-117 are canceled by this Amendment without prejudice, and Applicant reserves the right to pursue these claims in continuation or divisional applications. New claims 118-123 have been added in the present paper.

Support for the new claims is found throughout the specification. No new matter is introduced in the new claims.

New Matter rejection under 35 U.S.C. § 132

On page 2 of the Final Office Action mailed April 4, 2007, the Examiner objects to the amendment of November 8, 2004, under 35 U.S.C. § 132 “because it introduces new matter into the disclosure.” In particular, the Examiner states that “Applicant provides SEQ ID NO:10 as 244 amino acids rather than 245 amino acid in the claimed provisional applications. However, the corresponding table legend to the sequences does not correspond [to] the sequence numbering. For example: T8: amino acids 68³-94 of SEQ ID NO:39 in the table legend for ³ in T8, lysine has been substituted for the leucine residue at position **69** of the full-length Tumstatin, however this position now is **68**.” (Original emphasis).

The Examiner has required a substitute specification. The same is filed herewith. Although the Preliminary Amendment filed October 16, 2002 addressed this very issue, confusion remains over the teachings. For clarity, Applicant has attached hereto the cover page and original amino acid sequences for Tumstatin, presented in the provisional patent applications. This substitute specification brings cohesion between the last-filed sequence listing (filed October 16, 2002) the sequences related to Tumstatin in the original provisional patent application, and the present tables and text. Thus, for example, the provisional patent applications and the current sequence listing indicate a leucine residue at position 68. The substitute specification, e.g., the table legend, also refers to the leucine at position 68. Additionally, substitute FIG. 18B and FIG. 42 are submitted herewith, further reflecting the original, now-corrected amino acid sequences of the instant subject matter. No new matter is introduced in the substitute specification.

Objections to the claims

The Examiner, on page 2 of the Final Office Action, rejected claim 112. This claim has been canceled, and the Applicant apologizes for the typographical error.

The Examiner next objects to claims 109 and 114, then claims 110 and 115 (on page 3 of the Action), for discrepancies between the amino acids presented in claims and the cited sequence listings. Although these claims have been canceled, Applicant notes that the amino acids sequences and references to the sequence listings appear in the new claims. They have been compared for accuracy. Applicant appreciates the Examiner's careful attention to detail. Applicants request withdrawal of the objection.

Rejections under 35 U.S.C. § 112

On page 3 of the Office Action, the Examiner rejects claims 108-117 under 35 U.S.C. § 112, first paragraph, for lack of enablement.

The Examiner notes that although particular mutations are enabled by the specification, for example, the Examiner states that the specification is enabling for "An isolated Tumstatin polypeptide of SEQ ID NO:10 having the amino acid sequence of SEQ ID NOS:38-42, wherein said mutated polypeptide has the ability to inhibit angiogenic activity or the ability to inhibit protein synthesis in endothelial cell," the Examiner maintains that the claims' preamble "mutated Tumstatin polypeptide" does not limit the claims to the specific mutations recited in the SEQ ID NOs:38-42. Applicants traverse the rejection.

Nevertheless, in an effort to expedite prosecution, claims 108-117 have been canceled. The new claims present a reasonable correlation between the scope of the claims and the scope of enablement. The new claims either follow the Examiner's explicit guidance, for which Applicant is grateful, or no longer recite "mutated Tumstatin polypeptide having" language. Hence, Applicant's respectfully request withdrawal of the rejection.

CONCLUSION

Applicant respectfully requests reconsideration of this application and allowance of the pending claims in view of the above amendment and remarks.

Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

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06/17/98
JCS94 U.S. PTO

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

A/PROV

PROVISIONAL APPLICATION FOR PATENT COVER SHEET

This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53(c).

Docket Number		BIDMC98-11p		Type a plus sign (+) inside this box ---- +	
INVENTOR(S)/APPLICANT(S)					
LAST NAME		FIRST NAME		MIDDLE INITIAL	RESIDENCE (CITY AND EITHER STATE OR FOREIGN COUNTRY)
Kalluri		Raghuram			28 Holyoke Street Boston, MA 02116
TITLE OF THE INVENTION (280 CHARACTERS MAX)					
ARRESTIN AND METHODS OF USE THEREOF					
CORRESPONDENCE ADDRESS					
Joyce C. Miller HAMILTON, BROOK, SMITH & REYNOLDS, P.C. Two Militia Drive Lexington					
STATE	Massachusetts	ZIP CODE	02173-4799	COUNTRY	U.S.A.
ENCLOSED APPLICATION PARTS (check all that apply)					
<input checked="" type="checkbox"/> Specification		No. of Pages	7	<input checked="" type="checkbox"/> Abstract	Page 13
<input checked="" type="checkbox"/> Claims		Pages	8-12	<input checked="" type="checkbox"/> Drawings	No. of Sheets 10
				<input type="checkbox"/> Small Entity Statement	
				<input type="checkbox"/> Other	(specify)
Method of Payment (check one)					
<input checked="" type="checkbox"/> A check or money order is enclosed to cover the Provisional filing fees.			PROVISIONAL FILING FEE AMOUNT (\$)		\$150.00
<input type="checkbox"/> The Commissioner is hereby authorized to charge filing fees to Deposit Account Number 08-0380.					

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

☒ No

☐ Yes, the name of the U.S. Government agency and the Government contract number are: _____

Respectfully submitted,

SIGNATURE

TYPED or PRINTED NAME Joyce C. Miller

Date

June 17 1998
Registration No. p42,890
(if appropriate)

☐ Additional inventors are being named on separately numbered sheets attached hereto.

DATE June 17, 1998
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      10      20      30      40
      *      *      *      *
GLX GKR GDS GSP ATW TTR GFV FTR HSQ TTA IPS CPE GTV PLY SGF
____1427 TO 1670 OF FULL LENGTH A3 CHAIN OF TYPE IV____>

      50      60      70      80      90
      *      *      *      *      *
SFL PVQ GNQ RAH GQD LGT LGS CLQ RFT TMP FLP CNV NDV CNF ASR
____1427 TO 1670 OF FULL LENGTH A3 CHAIN OF TYPE IV____>

     100     110     120     130
      *      *      *      *      *
NDY SYW LST PAL MPM NMA PIT GRA LEP YIS RCT VCE GPA IAI AVH
____1427 TO 1670 OF FULL LENGTH A3 CHAIN OF TYPE IV____>

     140     150     160     170     180
      *      *      *      *      *
SQT TDI PPC PHG WIS LWK GFS FIM FTS AGS EGT GQA LAS PGS CLE
____1427 TO 1670 OF FULL LENGTH A3 CHAIN OF TYPE IV____>

     190     200     210     220
      *      *      *      *      *
EFR ASP FLE CHG RGT CNY YSN SYS FWL ASL NPE RMF RKP IPS TVR
____1427 TO 1670 OF FULL LENGTH A3 CHAIN OF TYPE IV____>

     230     240
      *      *
AGE LEK IIS RCQ VCM KKR H
____1427 TO 1670 OF FU____>

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Fig. 10

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

A/PROV

PROVISIONAL APPLICATION FOR PATENT COVER SHEET

request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53(c).

03/25/99 15520 U.S. PRO

Docket Number BIDMC99-04p					
INVENTOR(S) / APPLICANT(S)					
LAST NAME	FIRST NAME	MIDDLE INITIAL	RESIDENCE (CITY AND EITHER STATE OR FOREIGN COUNTRY)		
Kalluri	Raghuram		28 Holyoke Street Boston, Massachusetts 02116		
TITLE OF THE INVENTION (280 CHARACTERS MAX)					
ANTI-ANGIOGENIC PROTEINS AND METHODS OF USE THEREOF					
CORRESPONDENCE ADDRESS					
Doreen M. Hogle HAMILTON, BROOK, SMITH & REYNOLDS, P.C. Two Militia Drive Lexington					
STATE	Massachusetts	ZIP CODE	02421-4799	COUNTRY	U.S.A.
ENCLOSED APPLICATION PARTS (check all that apply)					
<input checked="" type="checkbox"/> Specification	No. of Pages <u>28</u>	<input checked="" type="checkbox"/> Abstract	Page <u>34</u>	<input type="checkbox"/> Small Entity Statement	
<input checked="" type="checkbox"/> Claims	Pages <u>29-33</u>	<input checked="" type="checkbox"/> Drawings	No. of Sheets <u>15</u>	<input type="checkbox"/> Other	(specify) _____
Method of Payment (check one)					
<input type="checkbox"/>	A check or money order is enclosed to cover the Provisional filing fees.			PROVISIONAL FILING FEE AMOUNT(\$)	150.00
<input type="checkbox"/>	The Commissioner is hereby authorized to charge filing fees to Deposit Account Number 08-0380.				

03/26/99 15511 U.S. PRO 60/126175

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

- ☒ No
- ☐ Yes, the name of the U.S. Government agency and the Government contract number are: _____

Respectfully submitted,

SIGNATURE

TYPED or PRINTED NAME

Joyce C. Miller

Date

March 25, 1999

Registration No. 42,890
(if appropriate)

- ☐ Additional inventors are being named on separately numbered sheets attached hereto.

DATE <u>03/25/99</u>
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FIG. 10